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10. (NEW) A method for performing transactions at a consumer transaction facility, comprising:

displaying selection options to transmit a transaction receipt to a destination address, print the transaction receipt at the consumer transaction facility, and both transmit the transaction receipt to the destination address and print the transaction receipt at the consumer transaction facility; and

displaying options, if transmission of the transaction receipt to a destination address is selected, to transmit the transaction receipt to a pre-selected destination address or to a different destination address.

#### REMARKS

Claims 1-9 are pending in this application and stand rejected. Claim 10 is newly added in this response.

#### The Objection to the Drawings

The Examiner objects to the drawings for not including reference number 86 as described on page 21 of the specification. Applicants provide a proposed drawing correction in red ink for Figure 12 with this response, including an accompanying Letter to the Examiner Requesting Approval of the Changes to the Drawings. Accordingly, Applicants respectfully request withdrawal of the objection to the drawings.

#### Rejections to the Claims: 35 U.S.C. §112, First Paragraph

Claims 1 and 7-9 have been rejected because the Examiner asserts the specification does not disclose providing options to the customer to transmit the receipt to the destination address

and to print the receipt at the facility. Applicants respectfully traverse this rejection for the reasons presented below.

The specification discloses providing options to the customer to both transmit the receipt to the destination address and print the receipt at the facility. For example, “[f]irst, it is determined whether the sheet receipt 38 is to be issued (step S15).” See Figure 4 of the specification and page 20, lines 22-23 of the specification. “After completion of the receipt issue processing, or in the event that the input of instructing no issuance of the sheet receipt 38 is made (step S15: absence), it is determined whether transmission to the electronic mail address is necessary (step S17).” See page 21, lines 7-11 of the specification. Thus, the specification does disclose providing options to both transmit the receipt to the destination address and print the receipt at the facility.

Accordingly, Applicants respectfully request withdrawal of the rejections to claims 1 and 7-9 under §112.

**Rejections to the Claims: 35 U.S.C. §§ 102(b) and 103(a)**

The Examiner rejected claims 1 and 7-9 under 35 U.S.C. §102(b) as being anticipated by Tognazzini (U.S. Patent No. 5,739,512). The Examiner also rejected claims 2-6 under 35 U.S.C. §103(a) as being unpatentable over Tognazzini. Applicants respectfully traverse these rejections for the reasons presented below.

**The Invention**

The present invention relates to a consumer transaction facility for performing banking services. The present invention allows a user to specify and send transaction records to a destination electronic mail address, and also allows the user to choose whether to receive a paper receipt of the transaction. Thus, the present invention provides the user with the

capability to store and manage transaction records from a personal computer and reduce wasteful use of paper.

The Reference

Tognazzini relates to digital delivery of receipts. In Tognazzini, a user's e-mail address is encoded in the user's credit card or smart card. When the user pays for a product or service, a digital receipt is automatically routed to the user's e-mail address. See Tognazzini at abstract; col. 2, lines 17-25.

The Present Claimed Invention Distinguishes Over the Prior Art

Claim 1 of the present invention recites "providing options to the consumer to choose from, the options being to transmit the transaction record to the destination address, print the transaction record at said facility, and both transmit the receipt to the destination address and print it at said facility."

While Tognazzini provides the ability to send a receipt to an e-mail address, Tognazzini does not appear to provide options for the user to also receive a paper receipt, or to both receive a paper receipt and receive the receipt at the e-mail address. In fact, Tognazzini teaches "the elimination of paper receipts." See Tognazzini at col. 2, lines 17-19. Also, Tognazzini teaches that an e-mail address can be incorporated into a bank card for automatic routing of the receipt to a user's e-mail address. See Tognazzini at abstract. Thus, it is submitted that claim 1 patentably distinguishes over the prior art.

Similar to claim 1, claims 7-9 provide the ability for a consumer to choose whether to receive a receipt at both an e-mail address and as a paper receipt. Thus, for the reasons presented above with respect to claim 1, it is submitted that claims 7-9 patentably distinguish over the prior art.

As for the dependent claims, the dependent claims depend from claim 1 and are patentable over the prior art for the reasons discussed above. The dependent claims also recite

additional features not taught or suggested by the prior art. For example, claim 4 recites that “it is selectable through said input means whether the transaction record is to be transmitted to the registered electronic mail address or an electronic mail address other than the registered electronic mail address.” These features are not taught or suggested by Tognazzini. Therefore, for at least this reason and the reasons set forth above with respect to claim 1, it is submitted that the dependent claims patentably distinguish over the prior art.

Furthermore, the Examiner asserts on pages 5 and 6 of the Office Action that the features of the dependent claims are obvious matters of design choice. “An assertion that the modification or feature is an obvious matter of design choice is an unsupported conclusion and not a valid basis for the rejection of a claim.” See In re Garrett, 33 BNA PTCJ 43 (U.S. P.T.O. Bd. App., November 13, 1986).

Considering, for example, claim 4 of the present invention, claim 4 provides the ability for a user to have a receipt sent to a pre-registered e-mail address, or to change the e-mail address at the transaction facility. In Tognazzini, a user’s e-mail address is incorporated into a bank card or smart card. Tognazzini does not appear to provide the user the ability to change the e-mail address at the transaction facility. Thus, it is respectfully submitted that there is no support for the Examiner’s assertion regarding design choice.

Therefore, Applicants submit that claims 1-9 patentably distinguish over the prior art. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under §§ 102 and 103.

#### New Claim

Claim 10 is newly added with this response to alternatively define the present invention. Claim 10 recites “displaying selection options to transmit a transaction receipt to a destination address, print the transaction receipt at the consumer transaction facility, and both transmit the transaction receipt to the destination address and print the transaction receipt at the

consumer transaction facility; and displaying options, if transmission of the transaction receipt to a destination address is selected, to transmit the transaction receipt to a pre-selected destination address or to a different destination address". These features are not taught or suggested by the cited reference. Thus, for at least the reasons presented above, Applicants submit claim 10 patentably distinguishes over the prior art. Accordingly, Applicants respectfully request allowance of the new claim.

### CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding rejections, the application is submitted to be in condition for allowance, which action is earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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